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**PATENT****Docket No. 2207/10554****IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant(s) : Y. HOSKOTE et al.

Serial No. : 09/802,616

Filed : March 9, 2001

For : **SYSTEM AND METHOD FOR AUTOMATICALLY  
MAPPING STATE ELEMENTS FOR EQUIVALENCE  
VERIFICATION**

Art Unit : 2128

Examiner : Fred O. Ferris III

Address to:  
Mail Stop Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, V.A. 22313-1450

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, V.A. 22313-1450 on

Date: January 6, 2005

Signature: Howard I. Grossman  
Howard I. Grossman, Reg. No. 48,673

**RESPONSE TO OFFICE ACTION**

Sir:

Transmitted herewith are the following documents for filing in the above-identified patent application:

1. Response to Office Action;
2. Request for Extension of Time under 37 C.F.R. 1.136(a).
3. The Commissioner is also authorized to charge payment of the following fees associated with this communication or credit any overpayment to the deposit account of **Kenyon & Kenyon**, deposit account number **11-0600**:
  - A. Any additional filing fees required under 37 C.F.R. § 1.16;
  - B. Any additional patent application processing fees under 37 C.F.R. § 1.17;
  - C. Any additional document supply fees under 37 C.F.R. § 1.19;
  - D. Any additional post-patent processing fees under 37 C.F.R. § 1.20; or
  - E. Any additional miscellaneous fees under 37 C.F.R. § 1.21.

5. A duplicate copy of this letter is enclosed.

Respectfully Submitted,

KENYON & KENYON

Dated: 1/6/05

By: Howard I. Grossman

Howard I. Grossman

Reg. No. 48,673

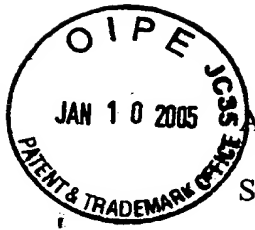
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

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Serial No. : 09/802,616

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**RESPONSE TO OFFICE ACTION**

S I R:

In response to the Office Action mailed on July 8, 2004 (the three-month response date for which has been extended by three months from October 8, 2004 to January 8, 2005 by the accompanying Transmittal And Petition To Extend), please reconsider the above-identified application based on the following:

**REMARKS**

Claims 1 to 21 are currently pending in the present application.

Claims 1, 18 and 20 have been rejected under 35 U.S.C. § 102(b)<sup>1</sup> as being anticipated by U.S. Patent No. 6,247,163 to Burch et al. (Burch).

In order for a claim to be anticipated under 35 U.S.C. § 102, a single prior art reference must disclose each and every element of the claim in exactly the same way. See Lindeman Machinenfabrik v. Am. Hoist and Derrick, 730 F.2d 1452, 1458 (Fed. Cir. 1984).

<sup>1</sup> Applicants note that the Burch reference does not qualify as prior art under §102(b) as it was not issued until June 12, 2001, which is after the filing date of the present application, March 9, 2001.